

REMARKS

Reconsideration of the present application is respectfully requested in view of the following remarks. Prior to entry of this response, Claims 1-31 were pending in the application, of which Claims 1 and 19 are independent. In the Office Action dated June 1, 2004, Claims 19-29 were rejected under 35 U.S.C. § 103(a), Claims 30-31 were objected to, but were deemed allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims, and Claims 1-18 were allowed pending an amendment to overcome a minor objection. Following this response, Claims 1-31 remain in this application. Applicant hereby addresses the Examiner's objections and rejections in turn.

I. Objection to the Claims

In the Office Action dated June 1, 2004, the Examiner objected to Claims 1-2 as containing various informalities. Claims 1-2 have been amended to address these informalities and do not narrow the claimed subject matter. Furthermore, the Examiner stated that Claims 1-18 are allowed pending an amendment to overcome these objections. Applicant respectfully submits that the amendments to Claims 1-2 overcome these objections and add no new matter. Applicant respectfully requests that the Examiner pass Claims 1-18 to issue.

II. Objection to the Drawings

In the Office Action, the Examiner objected to the drawings stating that the line for reference numeral 120 in FIG. 2 is pointing to the wrong element. Subject to the

approval of the Examiner, it is proposed to substitute FIG. 2 with the attached substitute FIG. 2. Applicant respectfully submits that substitute FIG. 2. overcomes this objection and adds no new matter.

Furthermore, the Examiner objected to the drawings stating that FIGs. 3, 4B, and 7 should be designated as --Prior Art-- because only that which is old is illustrated. Subject to the approval of the Examiner, substitute FIGs. 3, 4B, and 7 are submitted designating FIGs. 3, 4B, and 7 as --Prior Art-- in red. Applicant respectfully submits that substitute FIGs. 3, 4B, and 7 overcome this objection and add no new matter.

III. Rejection of the Claims Under 35 U.S.C. § 103(a)

In the Office Action, the Examiner rejected Claims 19-29 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,753,985 ("*Redlich*") in view of U.S. Patent No. 5,514,224 ("*Panchanathan*"). Furthermore, the Examiner rejected Claims 19-29 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 4,090,112 ("*Silverstone*") in view of U.S. Patent No. 5,514,224 ("*Panchanathan*"). In addition, the Examiner objected to Claim 30-31 as being dependent upon rejected independent Claim 19. Applicant respectfully traverses this rejection and objection.

Claim 19 is patentably distinguishable over the cited art in that it recites, for example, "a diametrically magnetized permanent magnet having at least one of a remanence of at least 10KG, a coercive force of at least 10KOe, an intrinsic coercive force of at least 12 KOe, and a maximum energy product of at least 30 MGOe." In contrast, and as admitted by the Examiner, neither *Redlich* nor *Silverstone* teaches or suggests the aforementioned recitation. Furthermore, *Panchanathan* does not

overcome *Redlich's* and *Silverstone's* deficiencies. *Panchanathan* merely discloses a remanence of about 10KG, but fails to teach, suggest, or disclose anywhere a coercive force of at least 10KOe, an intrinsic coercive force of at least 12 KOe, or a maximum energy product of at least 30 MGOe.

As a result, Applicant respectfully suggests that the Examiner has failed to make a *prima facie* case of obviousness. In order to make a *prima facie* case of obviousness, the Examiner must set forth prior art which teach or suggest every claim limitation. (See MPEP § 2143.) If the Examiner continues to rely on this unsupported contention, Applicant respectfully requests the Examiner to provide support. See, In re Zurko, 258 F.3d 1379, 59 U.S.P.Q.2d 1693 (Fed. Cir. 2001) (holding that the USPTO must point to some concrete evidence in the record to support core factual findings in a determination of patentability); Memorandum by Stephen G. Kunin, Deputy Commissioner for Patent Examination Policy (February 21, 2002)(stating that it is never appropriate to rely on common knowledge without evidentiary support as sole or principal evidence on which to base rejection); 37 C.F.R. § 1.104 (providing that when a rejection in an application is based on facts within the personal knowledge of an Examiner, the data should be stated as specifically as possible, *and the facts must be supported*, when called for by the applicant, by an affidavit from the Examiner); MPEP § 2144.03 (providing that the Examiner may only take official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being "well-known" in the art and, if the Applicant traverses such an assertion, the Examiner *should cite a reference* in support of his or her position.).

In sum, combining *Redlich* or *Silverstone* with *Panchanathan* does not render obvious the claimed invention because *Redlich*, *Silverstone*, and *Panchanathan*, either individually or in combination, at least do not disclose or suggest a coercive force of at least 10KOe, an intrinsic coercive force of at least 12 KOe, or a maximum energy product of at least 30 MGOe, as recited by Claim 19. Accordingly, independent Claim 19 patentably distinguishes the present invention over the cited art, and Applicant respectfully requests withdrawal of this rejection of Claim 19.

Dependent Claims 20-29 are also allowable at least for the reasons above regarding independent Claim 19, and by virtue of their dependency upon independent Claim 19. Accordingly, Applicant respectfully requests withdrawal of this rejection of dependent Claims 20-29. Moreover, Applicant respectfully requests withdrawal of the objection to dependent Claims 30-31 at least for the reasons above regarding independent Claim 19, and by virtue of their dependency upon independent Claim 19.

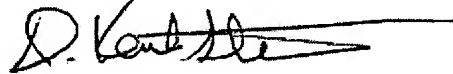
IV. Conclusion

In view of the foregoing remarks, Applicant respectfully requests the reconsideration and reexamination of this application and the timely allowance of the pending claims. The preceding arguments are based only on the arguments in the Office Action, and therefore do not address patentable aspects of the invention that were not addressed by the Examiner in the Office Action. The claims may include other elements that are not shown, taught, or suggested by the cited art. Accordingly, the preceding argument in favor of patentability is advanced without prejudice to other bases of patentability.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: September 1, 2004

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AMENDMENT TO THE DRAWINGS:

Subject to the Examiner's approval, please substitute FIGs. 2, 3, 4B, and 7 with the attached substitute FIGs. 2, 3, 4B, and 7.